

REMARKS/ARGUMENTS

Claims 1-18 were pending in this application before the present response.

Claims 17 and 18 are amended to correct dependencies. No new matter is added.

No amendment made is related to the statutory requirements of patentability unless expressly stated herein. No amendment is made for the purpose of narrowing the scope of any claim. Any remarks made herein with respect to a given claim or amendment is intended only in the context of that specific claim or amendment, and should not be applied to other claims, amendments, or aspects of Applicant's invention.

Claims 1-18 are now pending in this application. Applicant respectfully requests reconsideration and allowance of all pending claims, in view of the amendments and following remarks.

Objection to the Claims

The Office Action dated March 6, 2008 states "[T]he numbering of claims is not accordance with 37 CFR 1.126... Misnumbered claims 15-19 have been renumbered to claims 14-18." The listing of claims filed herewith has been corrected, and claims 17 and 18 are amended to correct claim dependencies. Applicant thanks the Examiner for renumbering the claims, and requests that the objection be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Rejection of Claims 1-6, and 14-18 under 35 U.S.C. § 103 (a) as being unpatentable over US 7,139,983 (Kelts) in view of US 5,966,120 (Arazi)

Applicant respectfully traverses the rejection of claims 1-6, and 14-18. Reconsideration is respectfully requested.

Applicant respectfully submits that the combination of Kelts and Arazi does not teach or suggest all the claim limitations as set forth in independent claim 1 and 16. For example, independent claims 1 and 16 recite "[an extractor module for] extracting [the] contents of the DVD into information files and video object files" which is not taught or suggested in the combination of Kelts and Arazi.

Kelts is directed to a navigation interface display system generating a navigation element that organizes television programming data in an easy-to-use manner. See Kelts, Abstract. No disclosure of “extracting contents of a DVD into information files and video object files” is present in Kelts. Kelts fails even to describe any automated extraction process which would reorganize DVD files (e.g., .VOB, .IFO, .BUP files) into presentation and navigational data. Kelts merely describes providing navigational information at the display device. Kelts provides no description or teaching about how navigational or other information can be obtained from a DVD.

For at least three reasons, Kelts fails to describe “extracting contents of a DVD into information files and video object files” as recited by independent claims 1 and 16.

Firstly, Kelts nowhere teaches “extracting contents . . . into . . . **video object files**” (emphasis added), as recited by independent claims 1 and 16. In fact, video object files or .VOB files are nowhere even mentioned in Kelts.

Secondly, Kelts also fails to teach “extracting contents . . . into **information files**” (emphasis added), as recited by independent claims 1 and 16. Kelts discloses that programming information is obtained from “individual application databases 606 [that] preferably contain broadcast and programming information such as cable television listings.” Kelts, col. 19, lines 35-37. Assuming, for the sake of argument, that the Examiner has equated the “information files” of the present application to the “individual application databases” of Kelts, Applicant points out that Kelts nowhere discloses any system or method for **extracting** these “individual application databases” from any other content. To the contrary, Kelts teaches that “the individual content providers and service providers will be responsible for updating and maintaining the data stored in application databases 606.” Kelts, col. 19, lines 52-54. Thus, Kelts does not disclose “extracting contents . . . into information files” as recited by independent claims 1 and 16.

Finally, Kelts fails to teach “extracting contents **of the DVD**” (emphasis added). The Office Action dated March 6, 2008 in item 3 on page 3 states “information files from the ‘selection items’ can inherently be from any source, e.g. DVDs... The video used for the VOD or PPV program can inherently be from any source, e.g. DVDs.” Applicant respectfully disagrees with the statement. The MPEP states, “[I]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the

determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” MPEP 2112 (quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). Applicant submits that the Office Action does not describe how it is obvious for a person having ordinary skill in the art to extract contents of a DVD into information files based on the teachings from Kelts.

The Examiner cites column 8, lines 18-40 of Kelts for this feature. The cited portion of Kelts merely describes that the display selection items may represent various types of data or information such as broadcast information, radio programs, pay per view programs, video on demand programs, locally recorded videos, and any combination thereof. See Kelts col. 8, lines 35-40. The Examiner characterizes this teaching of Kelts by noting, at page 2 of the Office Action, “The selection items being typical movies/programs that can be [] ordered via VOD or PPV.” Applicant agrees with the Examiner that Kelts is directed to the “typical” programs enumerated at col. 8, lines 35-40 of Kelts. Applicant further points out that the list of items at col. 8, lines 35-40, is closed, not open-ended, because Kelts includes no broadening language (language such as “e.g.,” “such as,” “for example,” “et cetera,” “comprising,” “and the like”) in the list. Thus, the disclosure of Kelts is limited to the examples disclosed, which do not include DVDs.

Applicant points out that Kelts has omitted DVDs from this list of items, and submits that the omission in Kelts is intentional. Kelts discloses that programming information is obtained from “individual application databases 606 [that] preferably contain broadcast and programming information such as cable television listings.” Kelts, col. 19, lines 35-37. Kelts specifically teaches, “In a **practical** system, the individual content providers and service providers will be responsible for updating and maintaining the data stored in application databases 606.” Kelts, col. 19, lines 52-54 (emphasis added).

Kelts **teaches away** from extracting information stored in DVDs. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)). Kelts teaches away from the use of programming data stored in DVDs, at least because DVDs typically contain read-only data that cannot be updated or maintained by a content provider or service provider. Kelts

teaches that “updating and maintaining the data” results in “a **practical** system” (*id.*); accordingly, a person of ordinary skill reading Kelts would logically conclude that “extracting contents of a DVD” – contents that cannot be updated or maintained – would result in an **impractical** system. Accordingly, a person of ordinary skill, upon reading the Kelts reference, would be led in a direction divergent from the path that was taken by the Applicant.

Applicant respectfully submits that Kelts fails to provide a basis for a rejection under 35 U.S.C. § 103, at least because Kelts expressly **teaches away** from “extracting contents of a DVD into information files and video object files” as recited by independent claims 1 and 16. Because Kelts is an **improper basis** for rejecting Applicant’s claims, the combination of Kelts with Arazi, or with other prior art references, is also an improper basis for rejecting Applicant’s claims. Accordingly, Kelts should be disqualified as a reference under 35 U.S.C. § 103(a).

Arazi fails to provide the foregoing feature that is missing from Kelts. Since Arazi fails to supply features missing from Kelts, the combination of Kelts and Arazi cannot suggest the invention and cannot render the claims obvious. Thus, no matter how Kelts and Arazi may be combined (even assuming, *arguendo*, that one of ordinary skill in the art would be led to combine them) the resulting combination is not the invention recited in claims 1 and 16.

In view of the foregoing, Applicant submits that independent claims 1 and 16 are not obvious in view of the combination of Kelts and Arazi, and therefore that the rejection of independent claims 1 and 16 under 35 U.S.C. § 103(a) should be withdrawn. Applicant requests that independent claims 1 and 16 now be passed to allowance.

Dependent claims 2-6, 14-15, and 17-18 depend from and include all the limitations of independent claims 1 and 16. Therefore, Applicant respectfully requests the reconsideration of dependent claims 2-6, 14-15, and 17-18 and requests withdrawal of the rejection.

Rejection of Claims 7-8 under 35 U.S.C. § 103 (a) as being unpatentable over US 7,139,983 (Kelts) in view of US 5,966,120 (Arazi) as applied to claim 1 and further in view of US2002/0047899 (Son)

Applicant respectfully submits that dependent claims 7-8 depend from, and include all the limitations of independent claim 1, which is deemed to be allowable for reasons provided above. Therefore, Applicant respectfully requests the reconsideration of dependent claims 7-8 and requests withdrawal of the rejection.

Rejection of Claims 9-13 under 35 U.S.C. § 103 (a) as being unpatentable over US 7,139,983 (Kelts) in view of US 5,966,120 (Arazi) as applied to claim 1 and further in view of US2002/0047899 (Son) as applied to claims 7-8 and further in view of US 2002/0078456 (Hudson)

Applicant respectfully submits that dependent claims 9-13 depend from, and include all the limitations of independent claim 1, which is deemed to be allowable for reasons provided above. Therefore, Applicant respectfully requests the reconsideration of dependent claims 9-13 and requests withdrawal of the rejection.

Conclusion

In view of the foregoing discussion, it is believed that claims 1-18 are allowable over the cited art. Claims not specifically discussed above are allowable due to their dependence on an allowable base claim. Applicant respectfully submits that all pending claims are in condition for allowance, and earnestly request that all objections and rejections of the claims be withdrawn and a Notice of Allowance be entered at the earliest date possible.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

Respectfully submitted,

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Date: July 7, 2008

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